United States Court of Appeals

for the Second Circuit

APPELLEE'S REPLY BRIEF

74-2455

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UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

HUGHLY PRODUCTS CORPORATION, RAPHAEL J. COSTANZO, BENJAMIN M. HINES, and LOIS D. HINES,

Plaintiffs,

RAPHAEL J. COSTANZO,

Plaintiff-Appellant,

CIVIL APPEAL
Docket 74-2455

vs.

STANLEY ARRON, VISA-THERM PRODUCTS, INC., MAX ARRON and ANNA ARRON,

Defendants-Appellees.

APPEAL FROM A JUDGMENT OF THE
UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF CONNECTICUT

REPLY BRIEF FOR DEFENDANT APPELLEE

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Timely claims the first Costanzo sock was constructed in February and March 1964 (P.Br.5). Arron says he learned of the possibilities of the heated sock from Robert McCarthy in December 1964 (657, 677). He returned to Costanzo and together they created a sock similar to DX-02. Costanzo's version overlooks amendments to sworn interrogatories (979), his deposition (965, 969) and a laboratory notebook of questionable validity (1165-75). Testimony of Joe DeMarco of Shelton Hosiery describing the unsuccessful efforts of Costanzo and Arron to develop a sock in early 1965 (359-60) supports Arron's testimony. The Shelton Hosiery (E.L. 97-106, Px-110) and Kaiser Roth (E.L.64-75,Px-30) agreements indicate, as the Court found, Costanzo and Arron were equal partners in the sock (Mem. 41).*

It is undisputed the aluminum foil heating element described in the Costanzo patent was created by Costanzo (See Defendant's Answer to Plaintiff Interrogatory #148, 151). This aluminum foil sock failed the J. C. Penney test (317-20, 805).

There are two principal areas of dispute:

1) Do the Arron and the Costanzo socks represent one invention or two?

2) Would Arron's sock be patentable over Costanzo if the Rule 131 Affidavit had not been filed?

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* (E.L.) refers to the Joint Exhibit List.

POINT I.

THE ARRON SOCK AND THE COSTANZO SOCK ARE TWO DISTINCT INVENTIONS.

Costanzo claims Arron stole his invention. This assertion requires the conclusion Arron's sock is identical, or substantially identical to Costanzo's sock. Costanzo made the same claim in the lower court, which found against him. There are, the District Court held, two separate socks.

> "....The Arron patent differs from the Costanzo patent in two respects: (a) the precise location of the heating element and (b) the amount of heat conductivity of the material covering the heating element...."
>
> (Mem. 14)

> "Costanzo contends that the Arron sock patent is invalid under 35 U.S.C. § 102 (a) and (f) because he, and not Arron, invented the electrically heated sock in Arron's patent application. This argument must fail because §102 prevents "patentability only where the invention was that 'identically disclosed' by the prior art." Ling-Temco-Vought Inc. v. Kollsman Instrument Corp., 372 F 2d 263 (2d Cir. 1967). Accord, Tate Planning Ltd. v. Tex-O-Graph Corp., 280 Supp. 226 (S.D. N.Y. 1968), aff'd. 423 F.2d 36 (2d Cir. 1970). The Arron invention is not identically disclosed by the Costanzo patent."
>
> (Mem. 21)

Separateness of the two socks is further established by the action of the Patent Examiner. Issuing the Arron patent, he concluded the Arron sock did not fall within the claims of the Costanzo patent. If Arron's sock did come within the Costanzo claims, he was bound to commence an interference proceeding. (1717-20) The Patent Examiner (the same for both patents) did not believe he was issuing two patents claiming the same invention.

Arron, in the Patent Office, (E.L.30-52,Px-2A)urged patentability based on localizing heat at a specific part of the foot. Costanzo, (E.L.5-26, Px-1A)urged patentability based on the spreading of heat over a large area. The two concepts are opposite, as the Examiner realized by granting two patents.

The most persuasive evidence, at least to this writer, is a comparison of the Arron sock with the language of the Costanzo patent. Claim 2 of the Costanzo patent (P.Br.p.11 b) requires a "radiation means"...electrically insulated from the resistor strip. The patent itself describes the "radiation means" as "metallic foil 25, such as aluminum foil or the like" (Costanzo Patent, Col. 3, Lines 64, 65).

Arron introduced evidence to prove the well known fact, good heat conductors (metallic foil and the like) are also good conductors of electricity (1422). This dual quality of metals is the reason Costanzo must electrically insulate the resistor strip from the radiation means. Costanzo claims an "expanded radiation surface" (claim 2(f)), a spreading of the heat over an area larger than the resistance ribbon.

A reading of the patent as a whole, together with Exhibit Dx-F1F, which is the sock with the Costanzo element submitted to J. C. Penney for testing (317-20, 805), forces a conclusion Costanzo, describing his invention, meant what he said. If the language used in the Costanzo patent encompasses all materials, metallic foil as well as cloth fibre, language

loses its meaning, and one cannot, by looking at this patent, come away with any idea of what is claimed.

If Costanzo's "radiation means" can be a material with heat insulating, rather than heat conducting, properties, his patent is invalid as ambiguous and indefinite. 35USC§112; Norton Company v. The Bendix Co. 171USPO 449, 449 F2d 553, CA2 (1971).

If Costanzo meant to invent Arron's sock, his patent, describing his aluminum foil application, is invalid because it does not describe the best embodiment known to the inventor at the time of the application so that a person skilled in the art can practice the invention. 35USC§112; Halliburton v. Schlumberger 130 F2d 589 CA5 (1942); 55USPO1; cert. denied 318US758.

Timely, through its expert Murphy, gives many reasons to prove Costanzo's sock is a non-obvious invention. These attributes are not of Costanzo's sock but Arron's. Murphy had never seen Costanzo's sock, only Arron's.

Murphy admitted Costanzo's aluminum foil sock Dx-F1F "could be" the sock described in the Costanzo patent and

> "I have never seen this sock before in my life. I would like to spend some time with it. (196)

nor had Murphy read the patent files. (231).*

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*Murphy was the only Timely witness that testified that Arron infringed Costanzo's patent. A Patent Attorney Expert (Weinstein) produced by Costanzo did not.

Murphy knew Timely's commercial socks (he made them) and he reaffirmed his affidavit (E.L. 160, Dx-F18) in which he stated Timely's commercial sock was identical to Arron's sock.

Arron urges his patent is valid for the same reasons Timely urges the Costanzo patent is valid, because Murphy's testimony is based on his knowledge of Arron's sock. When Costanzo's patent is understood to require metal sheets to spread heat, it's validity is irrelevant to Arron. Costanzo has nothing but a "paper" patent whose subject matter has never been manufactured, sold or distributed. Taylor v. Ford Motor Co., 154USPO 353, D.C.W.D. Tenn.

Even so, Arron proved Costanzo's sole contribution, metal conductors to spread heat, was an obvious attempt to reach the same result as the 6 volt sock.

Timely urges (Pl.B 66-68) the trial court's decision should not have invalidated claims (1, 3 and 8) which were not in issue. The whole patent was before the Court. Differences between the invalidated claim and the other claims do not of themselves, make the other claims patentable. Because of the paramount interest of the public, the lower court was required to look at the entire patent, and it found no invention in any of it.

Timely "initally invested between $30,000 and $60,000 to develop Plaintiff's concept to make it a commercial reality...." (P.Br. 51). It just attempted to develop the

aluminum foil concept (as indicated by the evolution of Timely's sock - see Defendants' Appendix P and actual court exhibits). Costanzo's aluminum foil concept could not be made to work. Timely then copied Arron's sock, which, when copied, had been on the market more than six months. Costanzo's claim of commercial success are spurious. His sock did not succeed. Arron's did.

POINT II.

ARRON WOULD HAVE OBTAINED A PATENT WITHOUT A RULE 131 AFFIDAVIT

Looking back, it is unfortunate Arron filed the 131 Affidavit, or in filing the affidavit, did not specifically mention Costanzo by name. Many collateral issues would have been avoided. The affidavit was filed in November 1967 and its purpose was to eliminate Timely's claim Arron's sock infringed the Costanzo patent. In answers to interrogatories filed in October 1967 (J.A. p. 2), Arron described the work done by Costanzo on their joint development of the sock as "He (Costanzo) developed at aluminum foil enclosure for the flat conductor and made performance tests of the same" (Interrogatory 107). Later (on Feb. 14, 1968) Arron's answers to interrogatories left no doubt Costanzo made the aluminum foil element used in the Jointly developed sock (Interrogatory 149, 151, 153). The trial judge noted Arron's patent application had been rejected on Costanzo prior to the filing

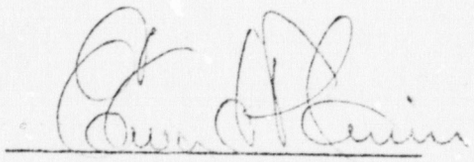
of the 131 Affidavit (Mem. 15). To patent counsel this initial rejection is not significant. Most applications (including Costanzo's) are initially rejected. The patent examination process is a process of distinguishing the application from previously claimed inventions. When the examiner is persuaded the proposed invention differs from the cited pending applications or patents, rejection is withdrawn and the patent issued.

Costanzo insists Arron would not have been granted his patent if it was not for the 131 Affidavit (P.Br. 70). The trial court, reviewing the same facts, concluded it would be speculation to conclude the 131 Affidavit was material to the issuance of the patent (Mem. 23,24).

Arron asserts his invention is patentable over Costanzo without the 131 Affidavit. He claims Costanzo's claim of infringement is so farfetched it establishes bad faith in sending the infringement letters, (on this point the respective claims are diametrically opposed). Validity of Arron's patent depends on its patentability over Costanzo which depends on whether Arron's sock is obvious if Arron knew of Costanzo's heating element. The successful sock is Arron's and the sock now in commercial use is Arron's. Arron did nothing in the patent office to justify his being deprived of the fruits of his invention. Timely, sending infringement letters for a patent they must have known was not infringed, obtained most of the market for Arron's invention.

If Arron's invention was not obvious when compared with Costanzo, his patent should be held valid, and Timely made to pay for its usurpation.

RESPECTFULLY SUBMITTED



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APPENDIX

35 USC§112. SPECIFICATION.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

* * * * * * * * * * *

This is to certify that two (2) copies of this Reply Brief have been sent via United Parcel Service (pre-paid) on the 17th day of April, 1975 to:

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